

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Philip S. Siegel
U.S. Patent Serial No.: 10/751,216
Filing Date: January 2, 2004
Group No.: 3627
Examiner: Mussa A. Shaawat
Confirmation No.: 1168
Title: ON-LINE MERCHANDISE RETURN LABELS

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

CORRECTED APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences ("Board") from the Final Office Action dated November 19, 2008. Appellants filed a Notice of Appeal and Appeal Brief with the statutory fee of \$270.00 on April 15, 2009. Applicants submit this corrected Appeal Brief in response to the Notification of Noncompliant Appeal Brief dated May 13, 2009. As requested by the Examiner, only the amended sections of the Appeal Brief are submitted now.

Status of Claims

Claims 1-5, 7, 8, and 10-32 are pending with Claims 17-28 being withdrawn. Claim 9 was cancelled in a Response submitted under 37 C.F.R. § 1.111 on November 9, 2005. Claim 6 was cancelled in a Response submitted under 37 C.F.R. § 1.111 on April 26, 2006.

Claims 1-5, 7, 8, 10-16, and 29-32 stand rejected pursuant to the Final Office Action dated November 19, 2008 ("*Final Office Action*"). Specifically, Claims 1-2, 5, 7-8, 13, 15, and 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). Claims 3-4, 10-12, 14, 16, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice.

For the reasons discussed below, Appellant respectfully submits that the rejection of Claims 1-5, 7, 8, 10-16, and 29-32 are improper and should be reversed by the Board. Accordingly, Appellant presents Claims 1-5, 7, 8, 10-16, and 29-32 for Appeal. All pending claims are shown in Appendix A, attached hereto.

Grounds of Rejection to be Reviewed on Appeal

Are Claims 1-2, 5, 7-8, 13, 15, and 30-32 unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*")?

Are Claims 3-4, 10-12, 14, 16, and 29 unpatentable under 35 U.S.C. § 103(a) over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice?

Arguments

The Examiner rejects Claims 1-2, 5, 7-8, 13, 15, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. (“*Arganbright*”) in view of U.S. Patent No. 6,246,997 issued to Cybul et al. (“*Cybul*”). The Examiner rejects Claims 3-4, 10-12, 14, 16, and 29 as being unpatentable over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. (“*Roman*”) and Official Notice. For at least the following reasons, Appellant respectfully submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1 and 32, and dependent Claims 16, 29, and 30 below.

I. Legal Standard for Obviousness

The question raised under 35 U.S.C. § 103 are whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. One of the three basic criteria that must be established by an Examiner to establish a *prima facie* case of obviousness is that “the prior art reference (or references when combined) must teach or suggest ***all the claim limitations.***” See M.P.E.P. § 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). “***All words*** in a claim must be considered in judging the patentability of that claim against the prior art.” See M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an Appellant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon Appellant’s disclosure is often difficult to avoid due to the very nature of the examination process. However,

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

The U.S. Supreme Court’s decision in *KSR Int’l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue “should be made explicit.” *KSR*, 127 S.Ct. at 1740-41. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the PTO in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO’s view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

II. Claims 1-2, 5, 7-8, 13, 15, and 30-32 are patentable under 35 U.S.C. § 103(a) over the Proposed *Arganbright-Cybul* Combination

The *Final Office Action* is deficient at least because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant’s Claims 1-2, 5, 7-8, 13, 15, and 30-32.

A. Claims 1-2, 5, 7-8, 13, 15, and 31-32 are Allowable

For example, independent Claim 1 of the present Application, as amended, recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server;
and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer.

Because the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest at least the claim elements emphasized above, Appellant submits that the rejection of Claim 1 is improper and should be withdrawn. Because independent Claim 32 recites certain similar claim elements, Appellant submits that the rejections of Claim 32 is improper for analogous reasons and should also be withdrawn.

1. **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing.”**

As a first example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest “receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing,” as recited in Claim 1. In the *Final Office Action*, the Examiner acknowledges that *Arganbright* does not disclose the recited claim elements and relies, specifically, upon *Cybul*. (*Final Office Action*, page 5). Appellant respectfully disagrees.

The cited portion of *Cybul* merely discloses “a list builder tool” that “efficiently find[s] and select[s] the past shopping history of respective shoppers and import[s] that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based “list builder tool.” The application finds and selects items previously purchased by the customer. The selection, however, is not by a customer, via a web access tool. The selection is not a click on the particular item of merchandise, and the selection does not identify a particular item of merchandise for returns processing. Accordingly, it continues to be Appellant’s position that neither *Arganbright* nor *Cybul* (or their proposed combination) disclose, teach, or suggest “receiving an **electronic selection, from the customer, via the web access tool**, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns**

processing,” as recited in Claim 1. The recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, Appellant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing. *Arganbright* discloses that the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. “If the user selects “return,” an online return form 2706 is presented to the user.” (Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant’s claim language would not have been obvious to one of ordinary skill in the art. As discussed above, *Cybul* relates to a system for online shopping that “takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor’s POS system “supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer,” the information may be extracted from the vendor’s POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can “efficiently

find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer's in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer's computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant's recited step of "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing," as recited in Claim 1.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

2. **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server."**

As a second example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of

merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for the operation of initiating a returns process by a returns server in response to a selection of an item. (*Final Office Action*, pages 4-5). Specifically, the Examiner states “*Arganbright* teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35).” (*Final Office Action*, page 10). Initially, Appellant respectfully notes that Appellant’s claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Appellant’s claim recites “initiating a returns process for the particular item of merchandise . . . by a returns server,” and this operation is not disclosed in *Arganbright*.

Arganbright merely discloses that “[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, this portion refers to the selection of either a “return” button or an “exchange” button by a user. Appellant points out that the selection of the “return” button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the “return” button occurs before an item of merchandise is identified for return. The mere presentation of form before the identification of the product to be returned is not analogous to “initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction,” as recited by Appellant’s amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing.

Appellant additionally notes that in the *Final Office Action* the Examiner relies upon *Cybul* for disclosure of the electronic selection of the particular item of merchandise and upon *Arganbright* for the operation of initiating a returns process by a returns server. (*Final Office Action*, pages 4-5). However, Appellant’s claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase

transaction, the returns process initiated by a returns server.” Thus, a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server.

To the extent that *Arganbright* discloses initiating a returns process by a returns server (which Appellant expressly disputes above), such returns process is not “in response receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise” from the customer. Appellant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section II(A) of this Appeal, *Cybul* does not even disclose the recited “electronic selection comprising the click on the particular item of merchandise” from the customer. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellant respectfully submits that the piecemeal rejection of Appellant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant’s claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

3. **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction.”**

As a third example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction

information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction,” as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for disclosure of receiving the electronic request to initiate return processing and upon *Cybul* for disclosure of accessing a database to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. (*Final Office Action*, pages 4-5). Appellant notes, however, that Appellant’s claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, an electronic request to initiate return processing is first received from a customer. Then, in response to that electronic request, a database is accessed to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. To the extent that *Cybul* discloses accessing a database to obtain transaction information associated with the customer, the operation is not “in response to receiving the electronic request to initiate return processing from the customer.” The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellant respectfully submits that the piecemeal rejection of Appellant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant’s claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

B. Claim 30 is Allowable

Dependent Claim 30 depends indirectly upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 30 is not obvious over the proposed combination of references at least because Claim 30 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the

cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 30.

For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer," as recited in Claim 30. In the *Final Office Action*, the Examiner relies specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 6). However, *Arganbright* merely discloses a program that "tracks a Member's shopping history." (*Arganbright*, Column 65, lines 7-10). Thus, the system of *Arganbright* stores a listing of the items that a customer purchases. There is no disclosure in *Arganbright* or the *Arganbright-Cybul-Roman-Official Notice* combination of "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer," as recited in Claim 30.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 30.

C. The *Arganbright-Cybul* Combination is Improper as Applied to Appellant's Claims

Furthermore, Appellant submits that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Arganbright* with *Cybul*.

According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no**

support or explanation of this conclusion and reversed.” See §2143.01 (I) (emphasis added). Thus, “the proper inquiry is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination.” *Id.* (internal quotations omitted) (emphasis original). “The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination.” See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, “it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) (emphasis added).

As applied to the present application, the *Final Office Action* has failed to meet this burden because the Examiner has not shown “something in the prior art as a whole to suggest the *desirability*” of combining *Arganbright* with *Cybul*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner only states “it would have been obvious . . . to incorporate the teachings of *Cybul* into the disclosure of *Arganbright* in order to provide the consumer with the option to return items via internet or online.” (*Final Office Action*, page 3). These bald assertions do not meet the requirements of the M.P.E.P. The Examiner did not provide “support or explanation” for the motivation to make the proposed combinations nor did the Examiner show any “desirability” of doing so. Instead, the Examiner seems to base this assertion on pure conjecture. The alleged advantages provided by the Examiner do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention ***without using Appellants’ claims as a guide*** to modify the particular techniques disclosed in *Arganbright* with the cited disclosure in *Cybul*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then

virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Appellant requests that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.

III. Claims 16 and 29 are patentable under 35 U.S.C. § 103(a) over the Proposed Arganbright-Cybul-Roman-Official Notice Combination

The *Final Office Action* is deficient at least because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's Claims 16 and 29.

A. Claim 16 is Allowable

Dependent Claim 16 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 16 is not obvious over the proposed combination of references at least because Claim 16 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 16.

For example, the proposed *Arganbright-Cybul-Roman-Official Notice* combination does not disclose, teach, or suggest "delivering data about the return to a customer account record," as recited in Claim 16. In the *Final Office Action*, the Examiner acknowledges that neither *Arganbright* nor *Cybul* disclose the recited claim elements and instead relies upon *Roman*. (*Final Office Action*, page 8). However, *Roman* merely discloses that the return product is "verified against the pre-authorized acceptance policy and the e-tailer is notified via the internet or direct connection between the e-tailer and ClickReturns.com." (*Roman*, Paragraph 22, lines 6-10). Thus, the cited portion of *Roman* only discloses that the merchant is notified of the return. There is no disclosure in *Roman* of "delivering data about the return to a customer account record," as recited in Claim 16.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 16.

B. Claim 29 is Allowable

Claim 29 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 29 is not obvious over the various combinations of references relied upon by the Examiner at least because Claim 29 includes the limitations of Claim 1. Additionally, dependent Claim 29 recites further elements that distinguish Appellant's claims over the prior art of record. For example, Claim 29 recites accessing a database to obtain customer information about the customer "wherein the customer information comprises customer-specific credit information or customer-specific shipping information." In the *Final Office Action*, the Examiner acknowledges that "[n]either Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information." (*Final Office Action*, page 8). However, the Examiner takes Official Notice that the claim elements are well known and old in the art. (*Final Office Action*, pages 8-9).

Appellant traverses the Examiner's taking of Official Notice. Although the M.P.E.P. suggests that it might not be unreasonable for the examiner to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence, the M.P.E.P. specifically states that Official Notice is only appropriate "provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection." (M.P.E.P., §2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.). Such is not the case here. For example, Claim 29 recites "the customer information comprises customer-specific credit information or customer-specific shipping information." There is no disclosure in *Arganbright*, *Cybul*, or *Roman* of these claim elements. Additionally, the recited claim elements do not "fill in the gaps" of *Arganbright*, *Cybul*, or *Roman*. Additionally, the Examiner has provided no evidence to support the Examiner's contention that Appellant's customer information comprising "customer-specific credit information or customer-specific shipping information," as recited in Appellant's dependent Claim 29, is indeed "old and well known" in the art.

In this case, it would not be appropriate for the examiner to take official notice of the claim elements of Claim 29 without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P., §2144.03). Accordingly, to the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Appellant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 29.

C. The *Arganbright-Roman-Cybul* Combination is Improper as Applied to Appellant's Claims

Furthermore, Appellant submits that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Arganbright* with *Cybul* and *Roman*.

According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no support or explanation** of this conclusion and reversed." See §2143.01 (I) (emphasis added). Thus, "the proper inquiry is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination." *Id.* (internal quotations omitted) (emphasis original). "The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination." See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR*

v. *Teleflex*, which recite, “it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) (emphasis added).

As applied to the present application, the *Final Office Action* has failed to meet this burden because the Examiner has not shown “something in the prior art as a whole to suggest the *desirability*” of combining *Arganbright* with *Cybul* and *Roman*, but rather seems to rely on a conjectured assertion that “the references can be combined” without regard to the “desirability of the combination.” This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner only states “it would have been obvious . . . to incorporate the teachings of *Cybul* into the disclosure of *Arganbright* in order to provide the consumer with the option to return items via internet or online.” (*Final Office Action*, page 3). Additionally, the Examiner states that “it would have been obvious . . . to incorporate the teachings of *Roman* into the disclosure of *Arganbright* in order to prevent the invalid return of merchandise.” (*Final Office Action*, page 7). These bald assertions do not meet the requirements of the M.P.E.P. The Examiner did not provide “support or explanation” for the motivation to make the proposed combinations nor did the Examiner show any “desirability” of doing so. Instead, the Examiner seems to base this assertion on pure conjecture. The alleged advantages provided by the Examiner do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention ***without using Appellants’ claims as a guide*** to modify the particular techniques disclosed in *Arganbright* with the cited disclosure in *Cybul* and *Roman*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Appellant requests that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.

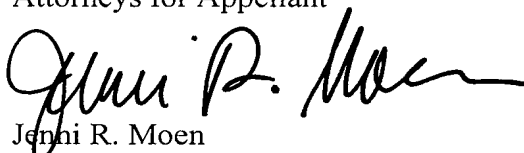
CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

No fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellant

A handwritten signature in black ink, appearing to read "Jenni R. Moen", is written over the printed name.

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APPENDIX A

Pending Claims

1. **(Previously Presented)** A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server; and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer.

2. **(Original)** The method of Claim 1, wherein the displaying step is performed by displaying a return information web page.

3. **(Original)** The method of Claim 2, further comprising the step, performed after the receiving step, of displaying a return confirmation message on a new web page.

4. **(Original)** The method of Claim 1, further comprising the step, performed after the receiving step, of displaying a return confirmation message on the return information web page.

5. **(Previously Presented)** The method of Claim 1, further comprising the step of accessing a database to obtain customer information about the customer, and wherein the displaying step includes displaying at least part of the customer information.

7. **(Original)** The method of Claim 1, further comprising the step of accessing a database to obtain merchant return rules.

8. **(Original)** The method of Claim 7, wherein the displaying step includes displaying at least one of the merchant return rules.

10. **(Previously Presented)** The method of Claim 1, further comprising the step, performed prior to the generating step, of determining whether the return is valid.

11. **(Original)** The method of Claim 10, further comprising the step of notifying the customer of an invalid return.

12. **(Previously Presented)** The method of Claim 10, wherein the step of determining whether the return is valid is performed by accessing one or more returns rules associated with the merchant.

13. **(Original)** The method of Claim 1, further comprising the step of notifying a merchant of the return item.

14. **(Original)** The method of Claim 1, further comprising the step of notifying a merchant of information about the customer.

15. **(Original)** The method of Claim 1, further comprising the step of downloading the data for printing a return label to the web access tool.

16. **(Original)** The method of Claim 1, further comprising the step of delivering data about the return to a customer account record.

29. **(Previously Presented)** The method of Claim 5, wherein the customer information comprises customer-specific credit information or customer-specific shipping information.

30. **(Previously Presented)** The method of Claim 1, further comprising:
in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer.

31. **(Previously Presented)** The method of Claim 1, further comprising electronically sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise.

32. **(Previously Presented)** A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request from the customer, accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating the customer profile associated with the customer; and

sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise.